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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,207	10/06/2000	Dimitri Kanevsky	YOR9-2000-0242-US1	2524

7590

03/17/2003

Paul D. Greeley, Esq.  
Ohlandt, Greeley, Ruggiero & Perle, L.L.P.  
10th Floor  
One Landmark Square  
Stamford, CT 06901-2682

EXAMINER

HAMILTON, MONPLAISIR G

ART UNIT

PAPER NUMBER

2172

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/684,207

Applicant(s)

KANEVSKY ET AL.

Examiner

Monplaisir G Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 and 43-46 is/are pending in the application.
- 4a) Of the above claim(s) 18-34 is/are ~~withdrawn from consideration~~ <sup>canceled</sup>.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Claims 1-34 were pending. The communication filed on 1/06/03 cancelled Claims 18-34 and added Claims 43-46. Claims 1-17 and 43-46 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to Claims 1-17 and 43-46 have been considered but are moot in view of the new ground(s) of rejection.

CFR 1.52 b (6) states that the paragraphs of the specification may be numbered. This language does not require applicant to number the paragraphs of the specification. Therefore, Examiner's objection to the specification has been withdrawn.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-13 and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5742039 issued to Sato et al, herein referred to as Sato, in view of US 5991876 issued to Johnson et al, herein referred to as Johnson.

Referring to Claim 1:

Sato discloses a method of filling an order for a right to make copies of a book comprising: (a) providing a label containing a record disposed on said book (col 4, lines 60-65; col 5, lines 1-5; col 7, lines 30-35), said record including a plurality of the members of the group consisting of: a title of said book, a web address of a copy tracker for said book, an identity of said order, a first number of copies of said entire book that are permitted to be made, a second number of copies of pages of said book that are permitted to be made and a third number of copies of pictures of said book that are permitted to be made (col 4, lines 15-20; col 7, lines 30-35);

Sato does not explicitly disclose the claimed “notifying a copy tracker that said record has been provided on said book” (col 10, lines 45-50).

Johnson discloses notifying a copy tracker that said record has been provided on said book (col 10, lines 45-50).

At the time the invention was made, it would have been obvious to a person of ordinary

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skill in the art to modify the teachings of Sato such that a copy tracker is notified that a record has been provided on said book. One of ordinary skill in the art would have been motivated to do this because it would allow an authorized reproduction of a certain number of the books (Johnson: col 10, lines 45-50).

Referring to Claims 6 and 11:

Sato discloses a transaction processor for filling an order for a right to make copies of a book comprising: a processing unit and a memory (Fig 6; col 7, lines 39-45); and an order procedure stored in said memory, wherein said order procedure includes: first means for controlling said processing unit to provide a label containing a record of said order ((col 4, lines 60-65; col 5, lines 1-5; col 7, lines 30-35)), wherein said record includes a plurality of members of the group consisting of: a title of said book, a web address of a copy tracker for said book, an identity of said order, a first number of copies of said entire book that are permitted to be made, a second number of copies of pages of said book that are permitted to be made and a third number of copies of pictures of said book that are permitted to be made (col 4, lines 15-20; col 7, lines 30-35; col 7, lines 40-67);

Sato does not explicitly disclose the claimed “notifying a copy tracker that said record has been provided on said book” (col 10, lines 45-50).

Johnson discloses notifying a copy tracker that said record has been provided on said book (col 10, lines 45-50).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Sato such that a copy tracker is notified that a record

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has been provided on said book. One of ordinary skill in the art would have been motivated to do this because it would allow an authorized reproduction of a certain number of the books (Johnson: col 10, lines 45-50).

Referring to Claim 2:

Sato in view of Johnson discloses the limitations as discussed in Claim 1 above. Sato further discloses the record includes at least said web address, and wherein said label is provided on a cover of said book (col 6, lines 1-5; col 7, lines 30-35; Fig 10).

Referring to Claim 3:

Sato in view of Johnson discloses the limitations as discussed in claim 1 above. Sato further discloses a portion of said record is provided on said label in machine readable form (col 4, lines 10-20).

Referring to Claim 4:

Sato in view of Johnson discloses the limitations as discussed in claim 2 above. Sato further discloses at least one portion of said record includes at least one member of the group consisting of: said web address and said identity (col 7, lines 30-35).

Referring to Claim 5:

Sato in view of Johnson discloses the limitations as discussed in claim 2 above. Sato further discloses said record includes at least said web address, and wherein said label is

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provided on one or more pages of said book (col 6, lines 1-5; col 7, lines 30-35; Fig 10).

Referring to Claims 7 and 12:

Sato in view of Johnson discloses the limitations as discussed in Claims 6 and 11 above. Sato further discloses provide said web address and said identity of said order on said label, and wherein said label is provided on a cover of said book (col 8, lines 15-45; col 6, lines 1-5; col 7, lines 30-35; Fig 10).

Referring to Claim 8:

Sato in view of Johnson discloses the limitations as discussed in Claim 7 above. Sato further discloses the transaction the web address is in machine readable form (col 7, lines 25-35; col 4, lines 10-20).

Referring to Claims 10 and 13:

Sato in view of Johnson discloses the limitations as discussed in Claims 6 and 12 above. Sato further discloses at least said web address and said identity, and wherein said label is provided on one or more pages of said book (col 6, lines 1-5; col 7, lines 30-35; Fig 10).

Referring to Claims 43-45:

Sato in view of Johnson discloses the limitations as discussed in Claims 1, 6 and 12 above. Sato further discloses said label is member of the group consisting of: printed matter, watermark, magnetic record, semiconductor device or any combination thereof (col 6, lines 1-

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15).

4. Claims 14-17 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5991876 issued to Johnson et al, herein referred to as Johnson in view of US 5742039 issued to Sato et al, herein referred to as Sato.

Referring to Claim 14:

Johnson discloses a method of making a copy of one or more pages of a book comprising: (c) obtaining from said copy tracker an electronic image of said pages; and (d) making a human readable image of said electronic image (col 2, lines 55-60; col 5, lines 20-40; col 7, lines 40-50) (b) using said web address to send to said copy tracker a request to make said copy, said request including an identity of a right to make said copies and an identification of said pages (col 10, lines 40-55; col 9, lines 65-67; col 10, lines 1-15);

Johnson does not explicitly disclose the claimed “(a) reading a record disposed on said book, wherein said record includes a web address of a copy tracker for said copies of said book”

Sato disclose reading a record disposed on said book, wherein said record includes a web address of a copy tracker for said copies of said book (col 7, lines 25-40).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify Johnson to read a record disposed on said book, wherein said record includes a web address of a copy tracker for said copies of said book. One of ordinary skill in the art would have been motivated to do this because it would allow a book holder to obtain a digital representation of a book (Johnson: col 2, lines 5-20; col 7, lines 40-50).



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Referring to Claim 15:

Johnson in view of Sato discloses the limitations as discussed in Claim 14 above. Sato further discloses reading said web address from a machine readable label on said book or on a page, picture or other image (col 7, lines 25-40).

Referring to Claim 16:

Johnson in view of Sato discloses the limitations as discussed in Claim 15 above. Johnson further discloses said human readable image is on a display (col 7, lines 40-55).

Referring to Claim 17:

Johnson in view of Sato discloses the limitations as discussed in Claim 15 above. Johnson further discloses said human readable image is on a hard copy media (col 7, lines 40-55).

Referring to Claim 46:

Johnson in view of Sato discloses the limitations as discussed in Claims 1, 6 and 12 above. Sato further discloses said label is member of the group consisting of: printed matter, watermark, magnetic record, semiconductor device or any combination thereof (col 6, lines 1-15).

***Final Rejection***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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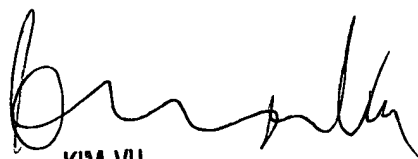
***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monplaisir G Hamilton whose telephone number is 1703-305-5116. The examiner can normally be reached on Monday - Friday (8:00 am - 4:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y Vu can be reached on 1703-305-4393. The fax phone numbers for the organization where this application or proceeding is assigned are 1703-746-7239 for regular communications and 1703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 1703-305-3900.

Monplaisir Hamilton  
February 28, 2003

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100